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**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Akio KOBAYSHI et al.

Group Art Unit: 1638

Application No.: 10/015,607

Examiner: D. Fox

Filed: December 17, 2001

Docket No.: 111473

For: A METHOD FOR INTRODUCING FOREIGN MATTERS INTO LIVING CELLS

**RESPONSE TO RESTRICTION AND ELECTION REQUIREMENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the combined Restriction and Election of Species Requirement mailed March 24, 2004, Applicants respond as follows.

Claims 1-18 are pending herein.

I. Restriction Requirement

Claims 1-18 are subject to a Restriction Requirement. In particular, the Office Action requires restriction between Group I (claims 1-15), Group II (claims 16-17), and Group III (claim 18). Applicants hereby elect Group I, claims 1-15, drawn to a method for transforming a cell. The election is made with traverse.

The Restriction Requirement asserts that Groups I, II and III are distinct, noting that Group I is classified in Class 435, Subclass 470, Group II is classified in Class 435, Subclass 421, and Group III is classified in Class 800, Subclass 298. Although Applicants agree that the inventions of Groups I, II and III may be independent or distinct as claimed, Applicants

respectfully submit that the Restriction Requirement between Groups I, II and III is improper, and should be withdrawn.

According to MPEP §803, there are two requirements that must be met before a proper restriction requirement may be made. These two requirements are: "The inventions must be independent . . . or distinct as claimed; and there must be a serious burden on the Examiner if restriction is not required . . . " (emphasis added). Applicants respectfully submit that the Office Action has failed to establish the second requirement set forth in MPEP §803, that a serious burden exists on the Examiner if restriction is required between the Groups of claims.

It is respectfully asserted that the search and examination of the entire application could be made without serious burden. MPEP §803 states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added). Because Applicants have elected Group I, directed to a method of transforming a cell, the further search and examination of Groups II and III would not place a serious burden upon the Examiner.

For at least these reasons, and in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office, it is respectfully requested that the Restriction Requirement be reconsidered and withdrawn.

## II. Election of Species Requirement

The Office Action also requires an election of species, if Group I or Group III is elected in response to the Restriction Requirement. In response to the Election of Species

Requirement, Applicants hereby elect species A, i.e., a method of making transformed plants.

This election is made with traverse.

In further response to the Election of Species Requirement, Applicants respectfully assert that at least claims 1 and 4-15 are generic to the elected species. Furthermore, Applicants respectfully assert that at least claims 1-15 read on the elected species.

Applicants traverse the election of species requirement on the ground that the generic claims are not so broad as to place an undue burden on the Patent Office to search and examine the full scope of the claims. Rather, Applicants respectfully assert that search and examination of the entire application could be conducted without undue burden on the Examiner, thus avoiding delay and expense to Applicants.

Applicants further understand, however, that upon search, examination and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the generic claims.